

REMARKS

Claims 1-47 stand rejected. Claims 1, 10, 16, 19, 20, 23, 25, 33, 35, 40 and 41 have been amended. Claims 48-55 have been added. Claims 1-55 are presently pending. Various typographical errors have been amended in the specification. The amendments to the specification and the claims do not add new matter and are supported by the originally filed specification. In view of the foregoing amendments and the following remarks, Applicant respectfully submits that all of the presently pending claims are allowable. Reconsideration of the Application is respectfully requested.

1. Rejection of claims 1-22, 33, and 34-47 (35 U.S.C. § 101)

Claims 1-22, 33, and 34-47 are rejected under 35 U.S.C. § 101 for allegedly being directed to non-statutory subject matter.

Claims 1, 10, 16, and 35 have been amended to improve their clarity. The Applicant respectfully submits that the amendments moot the non-statutory subject matter rejection of these claims.

The Applicant submits that dependent claims 2-9, 11-15, 17-22, 34, and 36-47 include all the limitations of their respective parent claims and also present statutory subject matter.

In light of the above, the Applicant requests withdrawal of the rejection of claims 1-22, 33, and 34-47 as being directed to non-statutory subject matter under 35 U.S.C. § 101.

2. Rejection of claims 1-32 (35 U.S.C. § 112, Second Paragraph)

Claims 1-32 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention.

In light of the amendments to the claims, the Applicant respectfully submit the rejection is moot. The Applicant submits that claims 1-32 are allowable and respectfully requests withdrawal the 35 U.S.C. § 112, second paragraph rejection.

3. Rejection of claims 1, 16-22, and 35-47 (35 U.S.C. § 102(b))

Claims 1, 16-22, and 35-47 stand rejected under 35 U.S.C. § 102(b), the Examiner alleging that these claims are unpatentable over U.S. Patent No. 5,273,281 to Lovell (“Lovell”). The Applicant respectfully traverses this assertion and submit that the rejections should be withdrawn for at least the following reasons.

To anticipate a claim, the reference must teach every element of the claim. *See* MPEP 2131. The identical invention must be shown in as complete detail as is contained in the claim. *See id.* (citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989)). Because Lovell does not teach all the elements of the claims, withdrawal of the 35 U.S.C. § 102(b) rejection is respectfully requested.

Lovell generally describes a game card and a method to play a game with the card. The game card is printed with a series of numbers divided into groups, each group associated with a group designator. The player guesses a sequence of a sub-group of randomly generated numbers. The player may win if he correctly guesses the identity and sequence of a sub-group of randomly generated numbers. See, e.g., Lovell Abstract.

With regards to claim 1, Lovell fails to describe the limitation “receiving a player-selected game option from a plurality of game options.” As pointed out by the Examiner, Lovell generally describes a “region 60 wherein a player can select the number of rounds his or her guesses in games 30, 40 and 50, respectively, are to be scored.” (Lovell, Col. 4, Lines 13-16). Region 60 indicates that a game card may be played multiple times with the player’s guesses as marked on the game card.

However, region 60 does not allow a player to select a game option as recited in claim

1. Each game in Lovell is always played in accordance with the same set of rules to determine whether the player wins. To win, the player must guess the numbers and the sequence of the numbers. (Lovell, Col. 4, Lines 27). Thus, Lovell does not describe “a player-selected game option.”

Similarly, Lovell does not anticipate amended claim 16. Amended claim 16 recites the limitation “receiving at least one player-selected game option.” Thus, Applicant respectfully submits the anticipation rejection of claim 16 should be withdrawn.

Claims 17-22 depend from claim 16 and thus should be patentable over Lovell for at least the same reasons as claim 17.

Claim 35 includes a limitation “selecting a game type from a plurality of game types to play in the game of chance, wherein one type in the plurality of game types provides an N number game and another type in the plurality of game types provides a one number game.” Lovell fails to describe a one number game. Thus, Applicant respectfully submits the anticipation rejection of claim 35 should be withdrawn.

Claims 36-47 depend from claim 35 and thus should be patentable over Lovell for at least the same reasons as claim 35.

For at least the foregoing reasons, Applicant submits that Claims 1, 16-22, and 35-47 are allowable and respectfully request withdrawal the 35 U.S.C. § 102(b) rejection.

4. Rejection of claims 2-15 and 23-32 (35 U.S.C. § 103(a))

Claims 2-15 and 23-32 stand rejected under 35 U.S.C. § 103(a), the Examiner alleging that these claims are unpatentable over U.S. Patent No. 5,273,281 to Lovell (“Lovell”) and further in view of Pick 3 and Win a Million.

Amended claim 23 recites, in relevant part, “determining whether the ticket was issued with a multi-play option, the multi-play option enabling a player to select a plurality of

game types and a plurality of game options for multiple ways to win on the same draw.” The multi-play option allows a player to play a game with more than one way to win. The player may select more than one game type of the number of numbers to be played and more than one game option of how to determine whether there is a match between the player selected numbers and the drawn numbers.

Neither Lovell in view of Pick 3 nor Lovell in view of Win a Million describe the “multi-play option” limitation. Thus, the Applicant respectfully submits that obviousness rejection of claim 23 should be withdrawn.

Similarly, claims 24-32 depend from claim 23 and thus should be patentable over Lovell in view of Pick 3 and Lovell in view of Win a Million for at least the same reasons as claim 23.

Similarly, claims 3-9 also depend from claim 1 and thus should be patentable over Lovell in view of Pick 3 and Lovell in view of Win a Million for at least the same reasons as claim 23.

Amended claim 10 includes the limitation “receive from the client terminal a player-selected option for multi-play, the option for multi-play enabling a player to select a plurality of game types and a plurality of game options for the game.” As above, neither Lovell in view of Pick 3 nor Lovell in view of Win a Million describe the “option for multi-play” limitation. According, since the proposed combination of references does not teach every limitation of the claim, the Examiner has not established a *prima facie* case of obviousness. Thus, the Applicant respectfully submits that obviousness rejection of claim 10 should be withdrawn.

Similarly, claims 11-15 depend from claim 10 and thus should be patentable over Lovell in view of Pick 3 and Lovell in view of Win a Million for at least the same reasons as claim 10.

Moreover, claim 9 recites “the plurality of available game types includes a one digit

game.” None of the cited references describe a one digit game. Thus, the Applicant submits that the obviousness rejection of claim 9 should be withdrawn.

With regards to claim 2, 10 and 23, the Examiner fails to provide a proper motivation to modify Lovell with the Pick 3 reference. The Examiner’s reasoning that the motivation to modify Lovell is to allow a player to vary the play and payout of the game is a hindsight reconstruction that has used the Applicant’s claimed invention as a roadmap to pick and choose features from the cited references. To reject, the Examiner must find a suggestion to combine the references that is “clear and particular.” *In re Dembicza*k, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999). The requirement is for “actual evidence” of the proposed motivation to combine. *Teleflex, Inc. v. Ficosa North America Corp.*, 299 F.3d 1313, 1334, 63 USPQ2d 1374 (Fed. Cir. 2002). Because no proper motivation to combine has been provided, Applicant respectfully submits the obviousness rejection should be withdrawn with regards to claims 2-7.

Pick 3 generally describes that a player may guess whether his numbers will be selected in sequence or not. However, nothing in Pick 3 or Lovell provides a suggestion to combine the any order option of Pick 3 with the game card and play method of Lovell. The Examiner cites no references or support suggesting players should be allowed to vary the play and payouts of the game. Thus, these two references are improperly combined and do not form a valid obviousness rejection.

Similarly, claims 3-7 depend from claim 1 as does claim 2 and include the “determining a selected game option” limitation. Thus, claims 3-7 should be patentable over Lovell in view of Pick 3 for the same reasons as claim 2.

Similarly, claims 24-32 depend from claim 23 and thus should be patentable over Lovell in view of Pick 3 for at least the same reasons as claim 23.

With regards to claims 8 and 9, the Examiner fails to provide a proper motivation to modify Lovell with the Win A Million reference. The Examiner’s reasoning that varying the number of digits available is a hindsight reconstruction with no support in the references.

Win A Million generally describes that a player may vary the number of digits he wishes to play in a game. However, nothing in Win A Million or Lovell provides a suggestion to combine the varying digit limitation of Win A Million with the game card and play method of Lovell. The Examiner cites no references or support suggesting players should be allowed to vary the number of digits played in the game. Thus, these two references are improperly combined and do not form a valid obviousness rejection.

With regards to claims 10-15, the Applicant respectfully submits the obviousness rejection be withdrawn based on the above arguments for claims 1-9.

For at least the foregoing reasons, Applicant submits that claims 2-15 and 23-32 are allowable and respectfully request withdrawal of all rejections.

5. New Claims 48-55

New claims 48-55 depend from claims 1, 10 and 16. Accordingly they should be allowable over the cited art of record for at least the reasons given above for claims 1, 10 and 16.

Moreover, claims 48 and 50 includes the limitation “receiving a player-selected option for multi-play, the option for multi-play enabling a player to select a plurality of game types and a plurality of game options for multiple ways to win.” As above, neither Lovell in view of Pick 3 nor Lovell in view of Win a Million describe the “option for multi-play” limitation. Thus, the Applicant submits claims 48 and 50 should be allowable over the cited art of record for at least this additional reason.

Appl. No. 10/681,071
Amendment addressing Office Actions of
January 12, 2005 and February 24, 2005

PATENT
12406/78

CONCLUSION

In view of the above amendments and remarks, it is respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

The Office is authorized to charge any fees associated with this Amendment to Kenyon & Kenyon Deposit Account No. 11-0600.

Respectfully Submitted,

KENYON & KENYON

Dated: June 24, 2005

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